

Applicant : Jean-Luc MARCHAL
USSN : 10/558,930
Filed : February 1, 2007
Examiner : John G. Pickett
Page : 2

Atty. Dkt. No. : 1143-PCT-US
Art Unit : 3728
Date of office action: April 16, 2009
Date of response : May 14, 2009

Election/Restrictions Requirement

The Examiner to whom this application is assigned indicated that under 35 U.S.C. § 121 and 372, restriction to one of the following groups of inventions is required:

- I. Group 1, Claims 1-17, drawn to a consumable package of a clear binder.
- II. Group 2, Claims 18-22, drawn to methods of use of a consumable package.

In response, Applicant respectfully traverses the above restriction.

Under 37 C.F.R. 1.475(b), an international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

Applicant submits that claims 1-22, Groups 1-2, recite, "A product and process of use of said product."

Applicant : Jean-Luc MARCHAL
USSN : 10/558,930
Filed : February 1, 2007
Examiner : John G. Pickett
Page : 3

Atty. Dkt. No. : 1143-PCT-US
Art Unit : 3728
Date of office action: April 16, 2009
Date of response : May 14, 2009

Applicant submits that claims 1-22, Groups 1 and 2, do not require restriction as they are connected by a single relationship, namely a consumable package of a clear-binder product and a packaging material, where the packaging material comprises a plastic or polymer material with a melting point from 50 to 100°C.

The Examiner has stated that the unifying technical feature "appears to be a consumable bag for the binder." The Examiner further states that such feature "was known in the art at the time of invention," and therefore "does not define a contribution over the prior art and cannot constitute a 'special technical feature' as defined in PCT Rule 13.2." The Examiner makes special reference to JP 11-321952 A.

Applicant attests that the single technical relationship is not the presence of a consumable bag, but instead the combined presence of a plastic or polymer material (of the enumerated melting point stated in the claims) together with the clear-binder product itself as a consumable package.

Because such a single technical relationship exists, the various methods of claims 18-22 (Group II), such as a method of transporting a clear-binder utilizing the package, or using a clear-binder in a process comprising adding a package to said process, or preparing a mixture comprising a clear-binder introducing the package to the mixture, etc., depend upon the consumable package of claims 1-17 (Group I). Accordingly, Applicant respectfully requests the restriction of claims 1-22 be withdrawn.

Applicant : Jean-Luc MARCHAL
USPN : 10/558,930
Filed : February 1, 2007
Examiner : John G. Pickett
Page : 4

Atty. Dkt. No. : 1143-PCT-US
Art. Unit : 3728
Date of office action: April 16, 2009
Date of response : May 14, 2009

Election of Invention

In the event the above discussion does not convince the Examiner to withdraw the restriction requirement, Applicant hereby elects Group 1, Claims 1-17, drawn to a consumable package of a clear binder.

If a telephone interview would be of assistance in advancing prosecution of the subject application, Applicant's undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee is deemed necessary in connection with the filing of this Response. However, if a fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 50-1891.

Respectfully submitted,

Albert Wai Kit Chan

Albert Wai-Kit Chan
Registration No. 36,479
Attorney for Applicant
Law Offices of
Albert Wai-Kit Chan, PLLC
World Plaza, Suite 604
141-07 20th Avenue
Whitestone, New York 11357
Tel: (718) 799-1000
Fax: (718) 357-8615
Email: chank@kitchanlaw.com